REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-2, 4-6, 8-9, 11, 13-16 and 21-25 are presently active in this case. The present Amendment amends Claims 1, 6, 8, 11, 13, 15-16 and 23 without introducing any new matter.

The outstanding Office Action rejected Claims 1, 8, 15, 21 and 23 under 35 U.S.C. §112, second paragraph, as indefinite. Claims 1-2, 4-6, 8-9, 11, 13-16 and 21-25 were rejected under 35 U.S.C. §102(e) as anticipated by Ohtsuka (U.S. Patent No. 6,327,049).

In response to the rejection under 35 U.S.C. §112, second paragraph, Claim 1 is amended to correct the noted informalities. In particular, Claim 1 is amended to recite "the result information being a result of an operation which is executed on the sent second image information in the information processing apparatus"[1] and to recite "a portion of the image information covered by any of the at least two elements, thereby not visible in a superimposed image of the at least two elements."[2] Independent Claims 8, 15, 21 and 23 are amended to recite similar features. In view of amended Claims 1, 8, 15, 21 and 23, it is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

Independent Claim 1 is amended to recite "the result information includes information indicating an order of the at least one element in the second image information in a direction perpendicular to a display screen." This feature finds non-limiting support in the disclosure

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[1] Finds non-limiting support in Applicants' Disclosure as originally filed, for example at page 24, lines 15-21 and at page 28, lines 6-24 and in corresponding Figures 9A-9B.
[2] Idem at page 27, lines 4-18.

as originally filed, for example from page 28, line 24 to page 29, line 9. Independent Claims 8, 15, 21 and 23 are amended to recite similar features. Independent Claim 13 is amended to recite "a first image information in a compressed format" and to recite "an intermediate process where the first image information stored in the storage is expanded,"[3] also for clarification purposes.

In addition, Claims 11 and 16 are amended to correct minor formalities. Since these changes are only formal in nature, they are not believed to raise a question on new matter.

In light of the amendments to the independent Claims 1, 8, 15, 21, and 23, Applicants respectfully request reconsideration of this rejection and traverse the rejection under 35 U.S.C. §102(e), as discussed next.

Briefly recapitulating, Applicants' Claim 1 relates to an image processing apparatus including, *inter alia*: a communication unit configured to communicate with an information processing apparatus, the information processing apparatus configured to operate on image information; a storage configured to store first image information which represents at least one element; and a controller configured to *send second image information to the information processing apparatus*, wherein the controller is *further configured to acquire result information*, the result information being a result of an operation executed for the sent second image information on the information processing apparatus, *the result information includes information indicating an order of at least one element in the second image information* in a direction perpendicular to a display screen; the controller is further configured to edit the first image information, the first image information is edited according to the acquired result information; and the *controller is further configured to send the edited first image information to the information processing apparatus* for printing. Independent Claims 6, 8, 11, 13, 15, 16, 21, 23 and 25 recite similar features in the context of a image

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[3] Idem at page 22, lines 16-26.

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processing apparatus (Claims 6 and 21), image processing method (Claims 8, 11, 23), image

information distribution method (Claim 13, 15, and 25), and a storage medium including a

computer readable program code (Claim 16).

Turning now to the applied reference, Ohtsuka discloses a printing service for

processed images, where data transfer can be reduced and the usage of image data and

templates can be limited.[4] Ohtsuka further explains that a user carries out processing

ordering from a laboratory 2, and that an *order file* describing image data and the template is

provided to the laboratory.[5] However, Ohtsuka fails to teach a controller being further

configured to send the edited first image information to the information processing apparatus

for printing. On the contrary, Ohtsuka explicitly explains that "templates used for generating

prints are *not provided to a user*, but stored in a system of a service provider only" (emphasis

added).[6] It can be further seen from Ohtsuka's Figures 1-2 that the user, employing his or her

terminal 5, merely provides an order file 6 to a laboratory system 2 for ordering an image at

the laboratory 2, and that the laboratory system, where the user is registered, provides a high

resolution image data 4.[7] Accordingly, Ohtsuka fails to teach or suggest the controller

configured to edit the first image information, and configured to send the edited first image

information to the information processing apparatus for printing, as claimed.

In addition, Ohtsuka's order file also does not provide information regarding the order

of the at least one element of the second image information in a direction perpendicular to a

display screen,[8] but provides other information related to the orderer's personal data, print

quality, etc.[9] Accordingly, a controller configured to acquire result information and

configured to edit first image information according to an order of image elements in a

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[4] See Ohtsuka in the Abstract, lines 1-4.
[5] See Ohtsuka in the Abstract, lines 4-10.
[6] See Ohtsuka at column 5, lines 44-47.
[7] See Ohtsuka at column 6, lines 58-65.
[8] See also Applicants' Figure 9A.
[9] See Ohtsuka from column 9, line 47 to column 13, line 45 and in Tables 1-8.

direction perpendicular to a display screen, as claimed by Applicants, *is not* a order receiving

center 7 with a program 41 carrying out processing and printing, according to the instruction

of a order file 6, as taught by <u>Ohtsuka</u>.[10] Consequently, <u>Ohtsuka</u> fails to teach or suggest the

controller being further configured to send the edited first image information to the

information processing apparatus for printing, since <u>Ohtsuka</u>'s teachings merely recite that an

order is sent to the printing laboratory.

As also recited in independent Claim 13, an image information distribution method

sends the edited first image information in the compressed format to the second image

processing apparatus from the first image processing apparatus. As explained above,

<u>Ohtuska</u>'s user terminal 5 merely sends order information to the laboratory system 2, and

does not send images itself that will be printed.

Therefore, the applied reference fails to teach or suggest every feature recited in

Applicants' claims, so that Claims 1-2, 4-6, 8-9, 11, 13-16 and 21-25 are patentably distinct

over the prior art. Accordingly, Applicants respectfully traverse, and request reconsideration

of, the rejection based on <u>Ohtsuka</u>.[11]

Consequently, in view of the present amendment, no further issues are believed to be

outstanding in the present application, and the present application is believed to be in

condition for formal Allowance. A Notice of Allowance for Claims 1-2, 4-6, 8-9, 11, 13-16
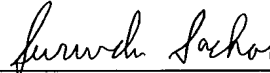
and 21-25 is earnestly solicited.

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[10] See <u>Ohtsuka</u> at column 9, lines 27-33 and in corresponding Figure 1.
[11] See MPEP 2131: "A claim is anticipated <u>only if each and every</u> element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Should the Examiner deem that any further action is necessary to place this

application in even better form for allowance, the Examiner is encouraged to contact

Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

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